

Attorney Docket No. LWEP:121US
U.S. Patent Application No. 10/735,394
Reply to Office Action of May 24, 2005
Date: August 24, 2005

Remarks

Objections to Claims 4 and 9-11

The Examiner objected to Claims 4 and 9-11 as lacking proper antecedent basis for the optical deflection element claim limitation. Applicants thank the Examiner for pointing out this error. Applicants have amended Claim 4 to properly depend from Claim 3 and have also amended Claims 4 and 9-11 to claim an “optical deflection element” rather than an “optical element”. Applicants respectfully request reconsideration and withdrawal of the objections to Claims 4 and 9-11.

The § 102 (e) Rejections of Claims 1-5 and 8-18

The Examiner rejected Claims 1-5 and 8-18 as under 35 U.S.C. § 102 (e) as anticipated by U.S. Patent Application No. 2002/0131165 to Takahama (“Takahama” or “the Takahama application”). Applicants have amended Claim 1 and respectfully traverse the rejection of that amended claim. Applicants respectfully request reconsideration.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. (Emphasis added.)

“Every element of the claimed invention must be literally present arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added.) Applicants have amended independent Claim 1 to claims the inverted microscope in which both the binocular tube (6) and the photo tube (7) extend above the horizontal changing surface (3). This amendment is supported by both Figure 1 and Figure 2 depicting the binocular tube and photo tube extending above the horizontal changing surface. In contrast, the Takahama application fails to disclose this claimed arrangement. In all the embodiments disclosed in Takahama, none show both the binocular tube and the photo tube as extending above a horizontal changing surface.

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In addition, Applicants respectfully traverse the Examiner's statement that Takahama discloses a horizontal changing surface on one limb of the microscope housing. The Examiner points to reference no. 51 as depicting a horizontal changing surface. However, in the Takahama application, reference no. 51 is designated as a mirror. Applicants courteously point to Figures 3 and 8 showing component 51 as reflecting light from an objective lens. In addition, component 51 is positioned at the bottom of the microscope housing and would not therefore be able to support a module located at the top of the housing. Finally reference no. 51 is referred to as a mirror in the specification of the Takahama application. (See paragraph 0052 in Takahama stating, "A reflection mirror 51 disposed in the bottom portion of the main body 1 reflects an imaging beam of the observed sample 2..."). Clearly, the Takahama application fails to disclose the horizontal changing surface as claimed in amended Claim 1.

Consequently, it can be seen that the Takahama application fails as a reference under § 102 (e) as it fails to both disclose each claim limitation as set forth in amended Claim 1, namely the horizontal changing surface and the claimed arrangement in which both the binocular tube and the photo tube extend above the horizontal changing surface. Applicants respectfully request reconsideration and passage to allowance of amended Claim 1.

Claims 2-5 and 8-18 depend directly or indirectly from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Takahama patent application fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 2-5 and 8-18. Applicants respectfully request the removal of the rejections of Claims 2-7 and 8-18 and passage to allowance of those claims.

The § 103 (a) Rejections of Claims 6, 7, and 19-48

The Examiner rejected Claims 6, 7, and 19-48 under 35 U.S.C. § 103 (a) as obvious over Takahama. Claims 6, 7, and 19-48 depend either directly or indirectly from amended Claim 1 and thus incorporate all the elements of that claim. Applicants respectfully traverse the rejections of Claims 6, 7, and 19-48 and request reconsideration.

To establish a *prima facie* case of obviousness there must be some suggestion or

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motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants courteously point out that Claims 6, 7, and 19-48 claim an embodiment in which both the binocular tube and the photo tube are above the horizontal changing surface. No where in Takahama is there any disclosure or suggestion to place both the photo tube and the binocular tube above the horizontal changing surface at the same time. Moreover, Applicants respectfully point out that Takahama fails to disclose a horizontal changing surface as claimed in Claims 6, 7, and 19-48. Because the Takahama application does not explicitly disclose either an inverted microscope in which the binocular tube and photo tube are both above a horizontal changing surface or the horizontal changing surface itself as claimed in Claims 6, 7, and 19-48, it fails as a reference under § 103 (a) to render Claims 6, 7, and 19-48 obvious. Also, because the Takahama application makes no suggestion to either place both the binocular tube and the photo tube over a horizontal changing surface, it fails for this additional reason to render Claims 6, 7, and 19-48 obvious under § 103 (a). Applicants respectfully request reconsideration and passage to allowance of those claims.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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